

Application Serial No. 10/065,397
Attorney Docket No. 33983 400200

REMARKS

Claims 1-9 were originally filed in the present application. Claims 2, 7 and 9 were previously cancelled and Claim 10 has been previously added. Claims 1, 3-6, 8 and 10 remain pending and at issue in this application. Of the remaining claims, Claims 1, 3, 8 and 10 have been amended.

Claims 1, 3-6, 8 and 10¹ have been rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 6,178,419 to Legh-Smith (herein "Legh-Smith"). In light of the present amendments and the arguments below, the applicant respectfully requests reconsideration of all claims. Applicant believes Claim 1 and Claim 10 distinguish over the cited references and should now be in condition for allowance.

Section 102(b) Rejections

Claims 1 and 10 have been amended to add the limitation "assembled without use of keywords from the keyword list" to describe the step of providing an Internet site and Internet page database. Support for this amendment can be found in the text of paragraphs [0006] through [0011] of the present application.

Claim 10 has also been amended to include the following limitation:

permitting keyword searching for an Internet site or Internet page having information relative to such Internet site or Internet page within the Internet site and Internet page database based on the at least one keyword assigned to each Internet site.

¹ The current PTO Action only lists Claims 1, 4-6, 8 and 10 because it incorrectly indicates that Claim 3 has also been cancelled. Claim 3, however, remains pending in the present application and is assumed to fall within the current rejection of all other claims.

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This limitation emphasizes that the assigned keywords to the Internet site remain coupled to the site to allow searching within the Internet site and Internet page database based on such keywords.

Legh-Smith teaches a method of controlling accessible Internet sites available to Internet searchers in the form of a directory-search methodology by only listing Internet sites already having specifically assigned keywords, and which are returned in a keyword search, conducted by a controller, based upon a predefined keyword list that is desired by a controller. To accomplish this, Legh-Smith creates a category list (300) and a keyword list (302) containing the keywords that the controller will search for Internet sites already having such keywords assigned to them. The keyword list (302) is created exclusively by the controller and lists the keywords to which the controller desires to limit search-returned Internet sites. (Col. 8, ln. 62 – Col. 9, ln. 1; Col. 9, ln. 28-35). As such, in order for the invention in Legh-Smith to find an Internet site, such Internet site must already have a keyword assigned to it which matches a keyword in the keyword list. Using keywords from the keyword list to assemble the Internet site and Internet page database is completely contrary to the limitations of amended Claims 1 and 10.

In other words, Legh-Smith's keyword list (302) is used exclusively to conduct a keyword search, where the controller searches for Internet sites already having an assigned keyword that matches a keyword in the list. (see Col. 5, ln. 9-11: "The keywords are for the purpose of building the database but do not, as such, form part of the ultimate database structure." (Emphasis added)).

The Internet sites that are returned in the keyword search are then categorized and scored. (Col. 5, lines 23-25). Legh-Smith teaches that "the list of URLs ... is cross-referenced back with the original description of categories and keywords, generated in step 302, to identify those

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URLs which are candidates for each category.” (Col. 5, lines 45-49). The identification of candidates is disclosed as a scoring system, wherein the keywords contained within the list for a category are searched within each Internet site to determine the Internet site’s relevance to a category. (Col. 5, lns. 45-49; col. 10, ln. 55-col. 11, ln. 46). If an Internet site does not already have a keyword assigned to it which matches a keyword contained within the keyword list, then the Internet site’s relevance to the category is lessened, thus removing the Internet site from the category. (Col 11, lns. 35-38).

In other words, the keyword lists in Legh-Smith are used to conduct the keyword searching for Internet sites that already have assigned their own keywords as well as assigning those Internet sites to a topical category based on the keywords which match the desired, listed keywords chosen by the controller. A database of such sites is then created. The entire process taught by Legh-Smith depends on some correspondence between the two sets of keywords.

As an earlier PTO Action points out, 35 U.S.C. 102(b) states:

A person shall be entitled to a patent unless—

(b) the invention was patented or described in a printed publication in this or a foreign country in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

In order for a reference to act as a §102 bar to patentability, the reference must teach each and every element of the claimed invention. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771 (Fed. Cir. 1983). Applicant contends that Legh-Smith fails to disclose the step of providing an Internet site and Internet page database “without use of keywords from the keyword lists.” This limitation is required by both independent Claims 1 and 10, as well as dependent claims 3-6 and 8.

Accordingly, the disclosure of Legh-Smith fails to properly support a rejection of the amended pending claims under 35 U.S.C. 102(b). Further, even if considered in combination

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with the other cited references to Conover et al. (U.S. Patent No. 6,701,314) or Burrows (U.S. Patent No. 5,745,899), such combination would not support a rejection as obvious under 35 U.S.C. 103(a). The pending claims, as amended, are considered to distinguish over each of these references, taken alone or in combination.

The present invention, as claimed, does not use its keyword list to actively conduct any search to find Internet sites that already have keyword assignments which match keywords contained in the list. The independent claims of the present application provide a topical category database and assign at least one keyword to that category to create a keyword list specific to that category. Then, the claimed invention assigns Internet sites to the categories and only then, after the Internet site or page has already been assigned to the category, it assigns or provides to the Internet sites keywords contained in the keyword list for that category they were respectively assigned to, regardless of any keywords that the Internet sites previously assigned to themselves. Legh-Smith, on the other hand, uses its keyword lists to conduct keyword based searches to populate its databases, and it does not assign any of the keywords contained in the list to any of the Internet sites. In fact, Legh-Smith achieves exactly the opposite of what the present application is trying to achieve, which is consistency of keyword search results. (See e.g., Paragraph [0030]).

Again, Legh-Smith relies exclusively on searching for the desired, predetermined keywords based only upon the keywords that the Internet site operators have already independently assigned to their respective Internet sites by their own independent determination. This teaching is diametrically opposed to the limitation now in independent Claims 1 and 10 of the present application. Accordingly, the applicant respectfully asserts that the claims are

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patentable over the prior art of record, either alone or in combination, and the applicant requests
the Examiner to reconsider and withdraw his rejections.

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CONCLUSION

Claims 1-9 were originally filed in the present application. Claims 2, 7 and 9 were previously cancelled and Claim 10 has been previously added. Claims 1, 3-6, 8 and 10 remain pending and at issue in this application. Of the remaining claims, Claims 1, 3, 8 and 10 have been amended. Claims 1, 3-6, 8 and 10 have been rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 6,178,419 to Legh-Smith (herein "Legh-Smith"). In light of the present amendments and the arguments set forth above, the applicant respectfully requests reconsideration of all claims. Applicant believes Claim 1 and Claim 10 distinguish over the cited references and should now be in condition for allowance. Likewise, dependent Claims 3-6 and 8 by virtue of their dependence on allowable Claim 1, are also considered allowable.

If any informalities remain which may be addressed by Examiner Amendment, the examiner is requested to phone the undersigned in order to expedite the prosecution of the present application.

Respectfully submitted,

By 

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